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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/410,462

10/01/1999

ANGELICA WILLIAMS

ONYX1046-ORD

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37499 7590 10/25/2007
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EXAMINER

ANGELL, JON E

ART UNIT

PAPER NUMBER

1635

MAIL DATE

DELIVERY MODE

10/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/410,462	Applicant(s) WILLIAMS ET AL.	
	Examiner J. Eric Angell	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 27 September 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☒ Newly proposed or amended claim(s) 8-10, 19, 20 and 34 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 26-28.
Claim(s) objected to: 8-10, 19, 20 and 34.
Claim(s) rejected: 6, 7, 11, 15, 17 and 18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/J. E. Angell/
Primary Examiner, AU1635

Continuation of 5. Applicant's reply has overcome the following rejection(s): The amendment to claims 11 and 15 obviate the rejection of claims under 35 U.S.C. 112, 1st paragraph (scope of enablement rejection). The cancellation of claims 12, 13, 16, 22, 23 and 29 renders all rejections against these claims moot.

Continuation of 13. Other: Applicants arguments against the rejection of claims 6, 7, 11, 15, 17 and 18 under 35 U.S.C. 102(e) have been fully considered but are not persuasive. Applicants contend that the reference (Bischoff et al.) does not teach all of the elements of the instant invention and the presently claimed invention is not a natural result flowing from the disclosure of Bischoff et al. Specifically, Applicants argue that Bischoff et al. does not teach a method for preferential killing of dividing endothelial cells compared to quiescent endothelial cells by a replication competent adenovirus. Applicants contend that Bischoff et al. makes no reference to endothelial cells and does not teach a mutant adenovirus that that replicates to higher titers in the dividing endothelial cells than wild type adenovirus. Applicants argue is improperly relying on inherency. In response, it is pointed out that the instant claims are drawn to a method comprising contacting a cell population comprising dividing and quiescent endothelial cells with a replication competent adenovirus comprising a mutation in the E1A CR2 RB family member binding region and allowing sufficient time for said mutant adenovirus to infect said cell population (e.g. see claim 11). It is noted that claims explicitly indicate that the mutation in the E1A-CR2 region is in Ad5 and comprises a deletion or substitution of one or more amino acids 111-123 or 122-129 (e.g., see claims 6 and 7). As previously indicated, Bischoff et al. teaches a mutant adenovirus comprising a deletion or substitution in the CR2 domain (amino acids 120-139) (see column 10, lines 10-25), and specifically teaches a mutant comprising a deletion of amino acids 2-150 (dl 1010) which completely deletes the CR1 and CR2 domains (see column 10, lines 25-40). Bischoff et al. teach that the mutant adenovirus can be used to treat various tumor types in a subject by directly administering the virus to the tumor (e.g., see column 16, lines 26-53). It is noted that patients comprising tumors comprise both dividing cells, such as proliferating cancer cells and proliferating microvascular endothelial cells associated with the tumor, as well as non-dividing non-cancerous cells. Therefore, Bischoff teaches administering an mutant adenovirus directly to tumor wherein the mutant adenovirus meets all of the structural limitations of the rejected claims. Therefore, administering the mutant adenovirus taught by Bischoff to a tumor would necessarily result in substantially and selectively killing dividing endothelial cells (including dividing microvasculature) and cancer cells in the subject. Applicant is reminded that MPEP § 2112.01 indicates, "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.'" Applicant is also reminded that MPEP § 2112 indicates, "[T]he claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)."; and, "There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003)." It is also noted that Ex parte Novitski, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993), indicates that a reference teaching a claimed process, wherein one of the claimed properties of a product used in the prior art process is inherent but undisclosed by the reference, may be properly applied as art against the claimed process. Furthermore, Integra Life Sciences I Ltd. v. Merck KGaA, 50 USPQ2d 1846 (DC SCalf, 1999) indicates that a reference teaching a process may anticipate claims drawn to a method comprising the same process steps, despite the recitation of a different intended use in the preamble or the later discovery of a particular property of one of the starting materials or end products. Therefore, Applicants arguments are not persuasive. It is noted that claims 8-10, 19, 20 and 34 are objected to, but if the base claims (claims 11 and 15) were re-written to include the limitation of these claims, all claims would be allowed. That is, limiting claims 11 and 15 such that the adenovirus was dl922/947, dl1107 or pm928 would obviate the rejections.